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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SEYFARTH SHAW 55 EAST MONROE STREET SUITE 4200 CHICAGO, IL 60603-5803			DADA, BEEMNET W	
			ART UNIT	PAPER NUMBER
			2135	

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,409

Applicant(s)GALEA, NICHOLAS PAUL
ANDREW**Examiner**

Beemnet W Dada

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-30 have been examined.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-5, 13-16, 18-20, 22, 23, 26-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al. (hereinafter Kim) (US Patent No. 6,701,440 B1).

4. As per claims 1 and 15, Kim teaches an anti-virus system for an electronic mail message, the system including detecting means for determining the presence of the electronic mail message (i.e., receiving an incoming email message at a remote e-mail server) [column 3, lines 34-37 and column 4, lines 4-13]; analysis and scanning detecting means for analyzing and scanning the electronic mail message for tags indicating the presence of operable program code and for removing any such tags and operable program code from the electronic mail message (i.e., scanning an e-mail message for virus and removing portion of the e-mail message if infected) [column 3, lines 34-61, column 8, lines 40-54 and column 9, lines 3-19];

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and application means for applying the electronic mail message, with the tags and operable program code removed, to server means [column 9, lines 43-45 and 55-60].

5. As per claim 3 and 18, Kim teaches the system as applied above. Furthermore, Kim teaches the system, wherein the analysis and scanning means comprise scanning means for scanning the message for predetermined character strings (scanning for virus such as known Macro language) [column 8, lines 40-54].

6. As per claims 4 and 19, Kim teaches the system as applied above. Furthermore, Kim teaches the system, wherein the application means for applying the electronic mail message with the tags and operable program code removed to server means includes replacement means for replacing the removed tag and operable program code with alternative text [column 3, lines 54- 58].

7. As per claims 5 and 20, Kim teaches the system as applied above. Furthermore, Kim teaches the system, wherein the replacement means is adapted to replace with alternative text for informing a recipient of the message that operable program code has been removed [column 3, lines 54-58 and column 9, lines 11-19].

8. As per claims 13 and 26, Kim teaches the system as applied above. Furthermore, Kim teaches the system, wherein the detecting means for determining the presence of the electronic mail message is adapted to capture electronic mail messages passing between a first network and a second network (a third party system receiving mail that is sent from a sender to a receiver) [column 4, lines 4-13 and figure 2].

9. As per claims 14 and 27, Kim teaches the system as applied above. Furthermore, Kim teaches the system, wherein the detecting means for determining the presence of the electronic mail message is adapted to capture electronic mail messages passing between an internal or private network and an external or public network [column 4, lines 4-13 and column 5, lines 8-24].

10. As per claim 16, Kim teaches the method as applied above. Furthermore, Kim teaches the method further comprises quarantining a message or a part of a message containing operable program code [column 8, lines 57-67 and column 9, lines 1-19].

11. As per claim 22, Kim teaches the method as applied above. Furthermore, Kim teaches the method wherein the step of quarantining a message or a part of a message comprises the steps of: storing a constituent body, attachment or macro of the message in a quarantine storage location as a quarantined item, receiving a decision whether the quarantined item may be delivered to an intended recipient, and dependant on the decision either releasing the quarantined item for delivery, with or without the operable code or macro deleted, to the intended recipient or deleting the quarantined item [column 8, lines 57-67 and column 9, lines 1-19].

12. As per claim 23, Kim teaches the method as applied above. Furthermore, Kim teaches the method wherein the step of deleting the quarantined item includes informing the intended recipient and/or a sender of the message that the quarantined item has been deleted without being delivered to the intended recipient [column 8, lines 57-67 and column 9, lines 1-27].

13. As per claims 28-30, Kim teaches the method as applied above. Furthermore, Kim teaches a computer program comprising code means for performing all the steps of the method of any of claims 15 to 27 when the program is run on one or more computers [column 3, lines 19-30].

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2, 6-12, 17, 21, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (US Patent No. 6,701,440 B1) in view of Ji et al (hereinafter Ji) (US Patent No. 5,889,943).

16. As per claims 2 and 17, Kim teaches an anti-virus system for an electronic mail message as applied above. Furthermore, Kim teaches scanning an e-mail message for virus including scanning attachments [column 5, lines 30-34]. Kim does not explicitly teach a decomposing means for breaking the message into constituent bodies or messages and attachments of the message and scanning the bodies and attachments and re-composition means for rebuilding the message from the constituent bodies and attachments. However, it is well known in the art

to decompose an email message into bodies and attachments and scan the bodies and attachments for detection of viruses. For example Ji teaches an anti-virus system where a message body part is scanned for viruses [column 11, lines 54-67 and column 12, lines 1-14] and an attachment part of the message is scanned for viruses [column 19, lines 40-67 and column 20 lines 1-27]. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a method of decomposing a message into bodies and attachments and scan bodies and attachments for viruses as per teachings of Ji into the anti-virus system of Kim, because scanning for attachments and bodies use different methods for detecting possible presence of viruses.

17. As per claim 6, the combination of Kim and Ji teach the system as applied above. Furthermore, Kim teaches the system wherein the analysis and scanning means include scanning means for scanning attachments for operable macros [column 1, lines 30-37 and column 5, lines 30-34].

18. As per claims 7 and 21, the combination of Kim and Ji teach the system as applied above. Furthermore, Kim teaches the system wherein the system further comprises quarantine means for quarantining a constituent body containing operable program code and/or removing from the message and quarantining an attachment containing a macro or operable program code [column 8, lines 57-67 and column 9, lines 1-19].

19. As per claim 8, the combination of Kim and Ji teach the system as applied above. Furthermore, Kim teaches the system wherein the quarantine means includes means for

removing a macro from an attachment, quarantining the macro and releasing the attachment with the macro removed [column lines 8, 57-67 and column 9, lines 1-19].

20. As per claim 9, the combination of Kim and Ji teach the system as applied above. Furthermore, Kim teaches the system wherein the quarantine means includes means for storing the constituent body, attachment or macro in a quarantine storage location as a quarantined item, receiving means for receiving a input indicating a decision whether the quarantined item may be delivered to an intended recipient, and dependant on the decision input either releasing the quarantined item for delivery to the intended recipient with or without the operable code removed or deleting the quarantined item [column 8, lines 57-67 and column 9, lines 1-29].

21. As per claim 10, the combination of Kim and Ji teach the system as applied above. Furthermore, Kim teaches the system wherein the quarantine means includes informing means, on deleting the quarantined item, for informing the intended recipient and/or a sender of the message that the quarantined item has been deleted without being delivered to the intended recipient [column 9, lines 1-29].

22. As per claims 11 and 24, the combination of Kim and Ji teach the system as applied above. Furthermore, Kim teaches the system wherein the scanning means for scanning attachments for operable macros comprises means for sequentially scanning the attachments for a plurality of predetermined character strings [column 1, lines 30-37 and column 5, lines 30-34].

23. As per claims 12 and 25, the combination of Kim and Ji teach the system as applied above. Furthermore, Kim teaches the system wherein the means for scanning attachments for a plurality of predetermined character strings includes termination means for terminating scanning when one of the predetermined strings is not found on completely scanning the attachment [column 1, lines 30-37 and column 5, lines 30-35].

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO Form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beemnet W Dada whose telephone number is (703) 305-8895. The examiner can normally be reached on Monday - Friday (8:30 am - 6:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (703) 305-4393. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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